

REMARKS

Summary Of Office Action

Claims 1-51 are pending in this application. The Examiner rejected claims 1-51 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,959,945 to Kleiman ("Kleiman") in view of U.S. Patent No. 4,829,569 to Seth-Smith et al ("Seth-Smith").

Summary of Applicants' Reply

By this Amendment, Applicants respectfully request entry of the claim amendments, including amendment of claims 3, 15, 24, 34, 40, 46, 47, and 51, to more distinctly claim what Applicants regard as their invention, and cancellation of claims 1, 2 , 4, 16, and 25 without prejudice or disclaimer of the subject matter thereof. Furthermore, Applicants respectfully traverse the Examiner's rejections for at least the reasons provided. Accordingly, Applicants respectfully request the timely allowance of claims 3, 5-15, 17-24, and 26-51.

Formal Matters

Applicants thank the Examiner for consideration of the materials submitted with the Information Disclosure Statement of September 3, 2002, and return of the initialed form PTO-1449. However, Applicants note that the returned form PTO-1449 is missing page 5 (of 8). Applicants therefore request that the Examiner return a copy of the signed page 5 with the next communication.

Reply to the Office Action

Claim Objections

The Examiner objected to claim 40 "as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

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claim and any intervening claims.” By this Amendment, Applicants seek to rewrite claim 40 in independent form, thus obviating this rejection. Accordingly, Applicants respectfully request entry of the amendment to, and allowance of, claim 40.

Claim Rejections

The rejections of claims 3, 5-15, 17-24, 26-39, and 41-51 as unpatentable under 35 U.S.C. §103(a) are respectfully traversed, since a *prima facie* case of obviousness has not been made by the Examiner. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the reference or references, taken alone or in combination, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” (See M.P.E.P. § 2143 (8th Ed. 2001)). Applicants submit that these requirements have not been met for at least the following reasons.

Independent claim 3, and dependent claims 5-14

Regarding the rejection of independent claim 3, there is recited a combination including, for example, “anti-piracy means for weaving into the recorded music selections an identification tag to identify the customer locations at which the recordings are made.” The Examiner has admitted that “Kleiman does not explicitly disclose that his central controller or central storage has an anti-piracy means or ID tag (or ID or header code) in the recorded music to identify the customer at which the recording is made.” While Applicants disagree with the Examiner’s

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paraphrasing of the claim, Applicants agree that the anti-piracy means of claim 3 is not disclosed by Kleiman. The Examiner asserted instead that Seth-Smith discloses that “the individual is enabled to receive encrypt/ decrypt (or ID tag) message...which is equivalent to the limitation detailed above wherein said an ID tag or ID in the record [sic] music to identify the customer at which the recording is made.” (Office Action at pp. 10-11) Applicants respectfully disagree and submit that Seth-Smith does not cure the deficiencies of Kleiman.

Claim 3 requires a combination including, for example, “anti-piracy means for weaving into the recorded music selections an identification tag to identify the customer locations at which the recordings are made.” In contrast, Seth-Smith at the excerpts asserted by the Examiner, discloses that the “assembled teletext, video and audio signal is encrypted and/or scrambled.” (Col. 6: 30-31.) In addition, “[t]he subscriber identification portion of the addressed packet is transmitted in clear text, that is, is not encrypted, so that it can be detected without decryption.” (Col. 6: 38-41.) The subscriber identification information therefore is part of a “packet” including encrypted music. However, because the music is encrypted, but the subscriber identification information is not, the identification information cannot possibly be “woven” into the recorded music. Therefore, Seth-Smith does not disclose “weaving into the recorded music selections an identification tag to identify the customer locations,” as required by claim 3.

Furthermore, it would not be obvious to one of ordinary skill in the art to modify the Seth-Smith system to achieve the present invention. In fact, Seth-Smith teaches away from “weaving” an identification tag into the record music selections. Seth-Smith encrypts the music to “secure it from unauthorized access”. (Col. 6:45-49.) At the same time, the identification

information “is not encrypted so that it can be read without decryption” (Col 6:40-41) so that a subscriber’s decoder may be “alert[ed]...that a message has been sent to it.” (Col. 6:36-37.) Thus, to accomplish its stated goals, the Seth-Smith system must encrypt the video or other content, but must specifically leave the identification information unencrypted. It would simply not be obvious to modify this system to weave any identification information into the music, as this would clearly offend the stated goals of the Seth-Smith system.

Finally, Seth-Smith also discloses that a fingerprint “bit causes the user identification number to be copied to the display for a single frame, such that any reproduction made of the program being transmitted at that time will include the user identification.” (Col. 10:34-38.) However, Applicants respectfully submit that this also does not disclose “weaving into the recorded music selections an identification tag to identify the customer locations,” as defined by the specification, and required by claim 3. First, Seth-Smith discloses only including such identification information in video or teletext data. (See Col. 10:33-39; Col. 24:16- Col. 25:10.) Applicants submit that the inclusion of identification tags into music presents problems not contemplated or addressed by Seth-Smith. For example, in Seth-Smith, ID tags are “displayed for a single frame” (Col. 10:35-36). However, such a scheme cannot be used with music selections, because there is no display or screen. Second, even assuming the inclusion of such identification tags in a video or teletext suggests inclusion of similar tags in music, simply including the identification number as part of the display is not “weaving” as defined by the specification.

Accordingly, Applicants submit that the Examiner has failed to set forth a prima facie case that Kleiman and Seth-Smith, alone or in any combination, render obvious the combination

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claimed in claim 3 including “anti-piracy means for weaving into the recorded music selections an identification tag to identify the customer locations at which the recordings are made.” Applicants therefore request the timely allowance of claim 3, and claims 5-14 depending therefrom.

Independent claim 15, and dependent claims 17-23

Regarding the rejection of independent claim 15, there is recited a combination including, for example, “the antipiracy feature includes an identification tag woven into the recorded music.” The Examiner has admitted that “Kleiman does not explicitly disclose that his central controller or central storage has an anti-piracy means or ID tag (or ID or header code) in the recorded music to identify the customer at which the recording is made.” (Office Action at p. 13.) While Applicants disagree with the Examiner’s paraphrasing of the claim, Applicants agree that the anti-piracy feature of claim 15 is not disclosed by Kleiman.

The Examiner, instead, asserted that Seth-Smith discloses that “the individual is enabled to receive encrypt/decrypt (or ID tag or header code) message...which is equivalent to the limitation detailed above wherein said an ID tag or ID in the record [sic] music to identify the customer at which the recording is made.” (Office Action at p. 13.) Furthermore, the Examiner asserted that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the music distribution of Kleiman by including the encrypted decrypted message ...taught by Seth-Smith” (Office Action at p. 14.) to achieve the claimed invention. Applicants respectfully disagree. In the discussion of claim 3, Applicants have set forth that Seth-Smith does not disclose or suggest at least “weaving” an ID tag into a “music” selection. Applicants respectfully submit therefore that Seth-Smith does not disclose or suggest

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that “the antipiracy feature includes an identification tag woven into the recorded music,” as required by claim 15.

Accordingly, Applicants submit that the Examiner has failed to set forth a *prima facie* case that Kleiman and Seth-Smith, alone or in any combination, render obvious the combination claimed in claim 15, including an “antipiracy feature includes an identification tag woven into the recorded music.” Accordingly, Applicants submit that claim 15, and claims 17-23 depending therefrom, are allowable.

Independent claim 24, and dependent claims 26-33

Regarding the rejection of independent claim 24, there is recited a combination including, for example, “anti-piracy means for weaving an identification tag into the recorded music.” The Examiner has admitted that “Kleiman does not explicitly disclose that his central controller or central storage has an anti-piracy means or ID tag (or ID or header code) in the recorded music to identify the customer at which the recording is made.” (Office Action at p. 16.) While Applicants disagree with the Examiner’s paraphrasing of the claim, Applicants agree that the anti-piracy means of claim 24 is not disclosed by Kleiman.

The Examiner, instead, asserted that Seth-Smith discloses that “the individual is enabled to receive encrypt/decrypt (or ID tag or header code) message...which is equivalent to the limitation detailed above wherein said an ID tag or ID in the record [sic] music to identify the customer at which the recording is made.” (Office Action at p. 16.) Furthermore, the Examiner asserted that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the music distribution of Kleiman by including the encrypted/decrypted message ...taught by Seth-Smith” (Office Action at p. 16.) to achieve the claimed

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invention. Applicants respectfully disagree. As noted above, in the discussion of claim 3, Seth-Smith does not disclose or suggest at least “weaving” an identification tag into “a music selection”. Applicants therefore submit that it cannot disclose or suggest “anti-piracy means for weaving an identification tag into the recorded music,” as required by claim 24.

Accordingly, Applicants submit that the Examiner has failed to set forth a *prima facie* case that Kleiman and Seth-Smith, alone or in any combination, render obvious the combination claimed in claim 24, including an “anti-piracy means for weaving an identification tag into the recorded music.” Accordingly, Applicants submit that claim 24, and claims 26-32 depending therefrom, are allowable.

Independent claim 34, and dependent claims 35-39, 41-45

Regarding the rejection of independent claim 34, there is recited a combination including, for example, “an anti-piracy module to weave an ID tag in the decoded music content.” The Examiner has admitted that “Kleiman does not explicitly disclose that his central controller or central storage has an ID tag (or ID) in the recorded music to identify the customer at which the recording is made.” (Office Action at p. 20.) While Applicants disagree with the Examiner’s paraphrasing of the claim, Applicants agree that the anti-piracy module of claim 34 is not disclosed by Kleiman.

The Examiner, instead, asserted that Seth-Smith discloses that “the individual is enabled to receive encrypt/decrypt (or ID tag) message...which is equivalent to the limitation detailed above wherein said an ID tag or ID in the record music to identify the customer at which the recording is made.” (Office Action at p. 20.) Furthermore, the Examiner asserted that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to

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modify the music distribution of Kleiman by including the encrypted/decrypted message ...taught by Seth-Smith" to achieve the claimed invention. Applicants respectfully disagree. As noted above, in the discussion of claim 3, Seth-Smith does not disclose or suggest at least "weaving" an ID tag into "music." Accordingly, Kleiman and Seth-Smith, alone or in any combination, fail to disclose or suggest at least "an anti-piracy module to weave an ID tag into the decoded music content," as required by claim 34.

Accordingly, Applicants submit that the Examiner has failed to set forth a prima facie case for obviousness. Applicants therefore submit that claim 34, and claims 35-39 and 41-45 depending therefrom, are allowable.

Independent claim 46

Regarding the rejection of independent claim 46, there is recited a combination including, for example, "an anti-piracy module weaving an ID tag in the decoded music content." The Examiner has admitted that "Kleiman does not explicitly disclose that his central controller or central storage has an ID tag (or ID) in the recorded music to identify the customer at which the recording is made." (Office Action at p. 20.) While Applicants disagree with the Examiner's paraphrasing of the claim, Applicants agree that the anti-piracy module of claim 46 is not disclosed by Kleiman.

The Examiner, instead, asserted that Seth-Smith discloses that "the individual is enabled to receive encrypt/decrypt (or ID tag) message...which is equivalent to the limitation detailed above wherein said an ID tag or ID in the record [sic] music to identify the customer at which the recording is made." (Office Action at p. 20.) Furthermore, the Examiner asserted that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to

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modify the music distribution of Kleiman by including the encrypted/decrypted message... taught by Seth-Smith" (Office Action at p. 21.) to achieve the claimed invention. Applicants respectfully disagree. As noted above, in the discussion of claim 3, Seth-Smith does not disclose or suggest at least "weaving" an identification tag into music. Applicants therefore submit that it cannot disclose or suggest "an anti-piracy module weaving an ID tag in the decoded music content," as required by claim 46.

Accordingly, Applicants submit that the Examiner has failed to set forth a prima facie case for obviousness. Applicants therefore submit that claim 46 is allowable.

Independent claim 47, and dependent claims 48-50

Regarding the rejection of independent claim 47, there is recited a combination including, for example, "an anti-piracy module weaving an ID tag in the received music content." The Examiner has admitted that "Kleiman does not explicitly disclose that his central controller or central storage has an ID tag (or ID) in the recorded music to identify the customer at which the recording is made." (Office Action at p. 20.) While Applicants disagree with the Examiner's paraphrasing of the claim, Applicants agree that the anti-piracy module of claim 46 is not disclosed by Kleiman.

The Examiner, instead, asserted that Seth-Smith discloses that "the individual is enabled to receive encrypt/decrypt (or ID tag) message...which is equivalent to the limitation detailed above wherein said an ID tag or ID in the record [sic] music to identify the customer at which the recording is made." (Office Action at p. 20.) Furthermore, the Examiner asserted that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the music distribution of Kleiman by including the encrypted/decrypted message...taught

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by Seth-Smith" (Office Action at p. 21.) to achieve the claimed invention. Applicants respectfully disagree. As noted above, in the discussion of claim 3, Seth-Smith does not disclose or suggest at least "weaving" an identification tag into "music". Applicants therefore submit that it cannot disclose or suggest "an anti-piracy module weaving an ID tag in the received music content," as required by claim 47.

Accordingly, Applicants submit that the Examiner has failed to set forth a prima facie case for obviousness. Applicants therefore submit that claim 47, and claims 48-50 depending therefrom, are allowable.

Independent claim 51

Applicants respectfully submit that the Examiner has failed to provide any detailed explanation of how Kleiman and Seth-Smith allegedly render claim 51 obvious. For at least the reasons provided above regarding claim 3, Applicants submit that neither Kleiman nor Seth-Smith disclose or suggest "weaving" an identification tag into music. Accordingly, Kleiman and Seth-Smith, either alone or in any combination, do not render obvious the combination claimed in claim 51, which includes "weaving an ID tag in the received music content." Applicants therefore request the timely allowance of claim 51.

Conclusion

In view of the foregoing amendments and remarks, applicants respectfully request reconsideration of this application and prompt allowance of claims 3-51.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 3, 5-15, 17-24, and 26-51 in condition for allowance. Applicants submit that the proposed amendments of claims 3, 15, 24, 34, 40, 46, 47, and 51 do

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not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants submit that entry of the amendments would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Attached hereto is a marked-up version of the changes made to the claims. The attachment is captioned "Appendix to Amendment of December 2, 2002 - Version with Markings to Show Changes Made." Deletions appear as normal text surrounded by brackets [] and additions appear as underlined text.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: December 2, 2002

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**APPENDIX TO AMENDMENT OF DECEMBER 2, 2002
VERSION WITH MARKINGS TO SHOW CHANGES MADE**

AMENDMENTS TO THE CLAIMS

3. (Amended) A system for distributing music to customers, comprising:
 - a data transmission system for transmitting a plurality of music selections;
 - a plurality of user stations at dispersed customer locations for receiving the transmitted music selections, the user stations including means for a customer to select and store one or more of the received music selections, and a recording device for permanently recording one or more of the stored music selections;
 - a central controller system;
 - a communications link between the customer locations and the central controller system to verify to the controller system when the stored music selections have been permanently recorded;
 - a billing system associated with the central controller system to bill the customer locations for the permanently recorded music selections; and
 - anti-piracy means for weaving into the recorded music selections an identification tag to identify the customer locations at which the recordings are made.

15. (Amended) A music distribution method, comprising:

- transmitting a plurality of music selections;
- using a plurality of user stations at dispersed customer locations, to receive and store the transmitted music selections;

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permanently recording one or more of the stored music selections;
using a communications link between the customer locations and a central controller system to verify to the controller system when the music selections have been permanently recorded;
using the central controller system to bill the customer locations for the music selections that are permanently recorded; and
providing the transmitted music selections with an anti-piracy feature to identify the customer locations at which the recordings are made, wherein the antipiracy feature includes an identification tag woven into the recorded music.

24. (Amended) A system for recording music, comprising:
a plurality of user stations at dispersed customer location for receiving transmitted music selections, each user station including means for a customer to select and record desired ones of the received music selections;
a central controller system; and
a communications link between each of the customer locations and the central controller system to verify to the controller system when the selected music selections have been recorded;
wherein the central controller system includes a billing system to bill the customer locations for the music selections that are recorded, and anti-piracy means for weaving an identification tag into the recorded music to identify the customer locations at which the recordings are made.

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34. (Amended) A system for distributing music to users, comprising:

a transmitter blanket-transmitting a plurality of encoded digital music contents;

a plurality of user stations comprising:

 a first input terminal receiving a user selection of a transmitted encoded music content to store;

 a module receiving and storing the selected transmitted encoded music content;

 an output terminal sending an indication of the user selection;

 a decoder operable when enabled to decode the stored encoded music content;

 a second input terminal receiving a key unique to the music content selected by the user to enable the decoder;

 an anti-piracy module to [embed] weave an ID tag in the decoded music content; and

 an output device supplying the decoded music content to the user from the decoder;

a central controller connected to the user stations and comprising a first input terminal receiving from a user station an indication of a user selection of a transmitted music content and a first output terminal transmitting to the user station a key unique to the selected music content; and

a billing system associated with the central controller to bill the user stations.

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40. (Amended) A [The] system [of claim 34,] for distributing music to users, comprising:
a transmitter blanket-transmitting a plurality of encoded digital music contents;
a plurality of user stations comprising:
 a first input terminal receiving a user selection of a transmitted encoded music
 content to store;
 a module receiving and storing the selected transmitted encoded music content;
 an output terminal sending an indication of the user selection;
 a decoder operable when enabled to decode the stored encoded music content;
 a second input terminal receiving a key unique to the music content selected by
 the user to enable the decoder;
 an anti-piracy module to embed an ID tag in the decoded music content; and
 an output device supplying the decoded music content to the user from the
 decoder;
 a central controller connected to the user stations and comprising a first input terminal
 receiving from a user station an indication of a user selection of a transmitted
 music content and a first output terminal transmitting to the user station a key
 unique to the selected music content; and
 a billing system associated with the central controller to bill the user stations, wherein the
 billing system processes payment transactions from the user stations and the
 central controller transmits the key only if a payment transaction for the key is
 completed in advance of the key transmission.

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46. (Amended) A user station for purchasing digital music contents, comprising:
a module receiving and storing blanket-transmitted encoded music contents;
an input terminal receiving a key unique to a recorded music content;
a decoder decoding the music content using the key,
an anti-piracy module [embedding] weaving an ID tag in the decoded music content; and
a terminal outputting the music content.

47. (Amended) A user station for distributing music to users from a transmitter
blanket transmitting a plurality of encoded digital music contents, comprising
a first input terminal receiving a user selection of a transmitted music content to store;
a module receiving and storing the selected transmitted music content;
an output terminal sending an indication of the user selection;
a second input terminal receiving a key unique to the music content selected by the user
to enable the decoder;
a decoder operable when enabled to decode the stored encoded music content;
an anti-piracy module [embedding] weaving an ID tag in the received music content; and
an output device supplying the decoded music content to the user from the decoder.

51. (Amended) A method for distributing music to users, comprising:
blanket-transmitting a plurality of encoded digital music contents to a plurality of user
stations;

receiving a user selection of a transmitted encoded music content to store;
receiving the selected transmitted encoded music content at a user station;
storing the selected transmitted encoded music content at the user station;
sending an indication of the user selection to a central controller;
receiving at the central controller from a user station an indication of a user selection of a transmitted music content;
transmitting to the user station a key unique to the selected music content;
receiving the key at a user station;
enabling a decoder at the user station to decode the stored encoded music content;
[embedding] weaving an ID tag in the received music content;
supplying the decoded music content to the user; and
billing the user for the supplied music content.

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